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REMARKS

Entry of this Amendment is proper because it does not raise any new issues requiring further search by the Examiner, narrows the issues on appeal, and is believed to place the present application in condition for immediate allowance.

It is noted that this Amendment is filed within two-months of the Office Action since the two-month due date of October 23, 2004 fell on a weekend. Thus, should any extension of time fees become necessary due to the issuance of an Advisory Action, any extension of time fees should be calculated from the date of the Office Action or the mailing date of the Advisory Action, whichever is later.

Claims 1-5, 7-9, 26-28, and 30-34 are all the claims presently pending in the application.

Independent claims 1 and 26-28 are amended merely to incorporate the features of dependent claim 29. Thus, no further search should be necessary. Indeed, claim 31 recites somewhat similar features. Therefore, these features should have been considered and searched by the Examiner in the present Office Action.

Claim 29 correspondingly is canceled without prejudice or disclaimer, while claim 30 correspondingly is amended to change its dependency from claim 29 to claim 28.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1-5, 7-9, 26-28, and 30-34 stand rejected under 35 U.S.C. § 103(a) as being obvious from the services provided by Icontact.com, i.e., "NetRep", as described in the articles

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"Online Stories Hope Shoppers say Aye to Watchful Assistants", Marriott, Michel, February 20, 2000, Sun Sentinel (hereinafter "the Marriott article") and "Internet's First Online Salesperson Technology Offered by Icontact.com, Inc." (Press Release, February 16, 2000) (hereinafter "Icontact.com Press Release").

These rejections are respectfully traversed in view of the following discussion.

I. THE CLAIMED INVENTION

The claimed invention, as defined in independent claim 1, is directed to a method for conducting electronic commerce that comprises browsing, by a user, for an item at an electronic store (e-Store) over an electronic medium, automatically recognizing, without human intervention, that the user is lost in attempting to find the item, and interactively querying by an electronic store assistant, at any time during a session, of the user whether the user needs help in finding the item, wherein the electronic store assistant is implemented in software as one of a program and a search window which is activated based on one of a query and activated automatically after a predetermined number of navigations by the user. The step of automatically recognizing includes considering a history of the browser based on a query entered in said browsing by a user, determining, based on said history and said query, whether an automated help resource is necessary, determining, based on said history and said query, whether a human help resource is necessary, and routing said user to at least one of said automated help resource and said human help resource, to help said user.

The claimed invention, as defined in independent claims 26-28, recite somewhat similar features as independent claim 1.

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Somewhat similarly, independent claim 31 recites a method for conducting electronic commerce, including browsing, by a user, for an item at an electronic store (e-Store) over an electronic medium, automatically considering, without human intervention, a history of said browser based on a query entered in said browsing by said user, automatically determining, without human intervention, based on said history and said query, whether an automated help resource should be launched, automatically determining, without human intervention, based on said history and said query, whether a human help resource should be contacted, automatically routing, without human intervention, said user to at least one of said automated help resource and said human help resource, to help said user.

An exemplary embodiment of the present invention provides extensive software sophistication to track user behavior, e.g., navigating, browsing, clicking, searching, etc., to determine what the user might be looking for. The present invention may include extensive facilities for the customer to practice his/her typical behavior using the Internet browser, i.e., navigating, browsing, clicking, or searching, and tracks these behaviors to provide help in a behavioral context by directing the customer to the appropriate category with dynamic help or a live person who can help either through a chat system or a phone line. The present invention may also encompass directing to a help category or to a person who is an expert in the area of the customer's query.

II. THE PRIOR ART REJECTIONS

Claims 1-5, 7-9, 26-28, and 30-34 stand rejected under 35 U.S.C. § 103(a) as being obvious from the services provided by Icontact.com, i.e., "NetRep", as described in the Marriott

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article and the Icontact.com press release. For at least the following reasons, Applicant respectfully traverses these rejections.

In the Response to Arguments, the Examiner states that “*Applicants’ arguments with respect to claims (sic) 1-5, 7-9 and 26-34 have been considered but are moot in view of the new ground(s) of rejection*” (see Office Action at page 5, lines 14-15).

The Examiner alleges that “[t]he Attorney argues that the claimed invention does not merely automate a manual activity that accomplishes the same result. Instead, the claimed invention recites a unique combination of elements that accomplishes clearly different results, which are not, disclosed (sic) or suggested by the method described by Icontact.com” (see Office Action at page 5, lines 16-19).

The Examiner further alleges that “page 1 of the specification of the instant invention discloses that the present invention relates to a system and method of electronic commerce and more particularly to a system and method for bringing an electronic shopping experience closer to a traditional shopping experience by defining an electronic store assistant which helps electronic shoppers who are lost while browsing for an item in an electronic commerce site” (see Office Action at page 5, line 20, to page 6, line 4).

The Examiner further alleges that “*this is expressly the result that is accomplished by Icontact.com, whereby Icontact.com allows e-commerce companies to replicate the proactive capabilities of a salesperson in a brick-and-mortar store. Icontact.com can proactively approach and assist a customer visiting a Web site just as a salesperson would when a customer enters a retail store*” (see Office Action at page 6, lines 5-9; emphasis added).

On the other hand, in rejecting claims 1-5, 7-9, and 26-34, the Examiner acknowledges that “*Icontact.com does not expressly disclose a method wherein said electronic store assistant is*

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implemented in software as one of a program and a search window which is activated based on one of a query and activated automatically after a predetermined number of navigations by said user” (see Office Action at page 3, lines 9-12; emphasis added).

However, the Examiner alleges that “simply automating the step of detecting when the customer needs help gives just what one would expect from the manual step as shown in ‘Icontact.com’” (see Office Action at page 3, lines 20-22; emphasis added), and thus, that “*it would have been obvious...to automate the step of determining when to intervene to facilitate a customer, using software, because this would speed up the process that is known in the art*” (see Office Action at page 4, lines 6-9; emphasis added).

Applicant respectfully disagrees with the Examiner’s position for several reasons.

Unlike Icontact.com, the present invention distinguishes between those user searches which do not need human assistance (i.e., which can be handled by software) and those user searches which would benefit from human assistance.

In Icontact.com, the only option is human intervention. Clearly, automatically providing human intervention, without first determining whether human or non-human intervention is appropriate, is not merely a manual version of the claimed invention. Indeed, since Icontact.com only teaches human intervention as the first point of contact, Icontact.com clearly is not capable of (and thus, does not disclose or suggest) determining whether human or non-human intervention is appropriate until after the human contact already has been made. Thus, contrary to the Examiner’s position, Icontact.com clearly does not accomplish the same result.

As the Examiner surely knows, in determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious (e.g.,

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see M.P.E.P. § 2141.02, *citing* Stratoflex, Inc., v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983)).

Distilling an invention down to the 'gist' or 'thrust of an invention' disregards the requirement of analyzing the subject matter 'as a whole' " (e.g., see M.P.E.P. § 2142.02, *citing* W.L. Gore & Associates, Inc., v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). That is, the Examiner cannot disregard express limitations in the claims, thereby treating the claims as though they read differently). Indeed, treating the advantage as the invention disregards statutory requirements that the invention be viewed 'as a whole' (e.g., see M.P.E.P. § 2142.02).

In this case, the Examiner erroneously appears to be narrowing the claimed invention down to the gist of the invention, rather than considering each and every element of the claimed invention. That is, the claimed invention does not merely provide a human representative that "*can proactively approach and assist a customer visiting a Web site just as a salesperson would when a customer enters a retail store*" as alleged by the Examiner (see Office Action at page 6, lines 5-9).

Instead, the claimed invention has the advantage of "automatically determining, without human intervention... whether an automated help resource should be launched" or "whether a human help resource should be launched", as defined, for example, by independent claim 31.

That is, unlike Icontact.com, the present invention distinguishes between those user searches which do not need human assistance (i.e., which can be handled by software) and those user searches which would benefit from human assistance.

In Icontact.com, the only option is immediate human intervention. Clearly, automatically providing human intervention, without first determining whether human or non-human

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intervention is appropriate, is not merely a manual version of the claimed invention. Indeed, since Icontact.com only teaches human intervention as the first point of contact, Icontact.com is not capable of determining whether human or non-human intervention is appropriate until after the human contact already has been made. Thus, Icontact.com clearly does not arrive at the "same result", as alleged by the Examiner.

For example, independent claim 1 recites, *inter alia*, a method for conducting electronic commerce, including:

browsing, by a user, for an item at an electronic store (e-Store) over an electronic medium;

automatically recognizing, without human intervention, that the user is lost in attempting to find said item; and

interactively querying by an electronic store assistant, at any time during a session, of said user whether the user needs help in finding said item,

wherein said electronic store assistant is implemented in software as one of a program and a search window which is activated based on one of a query and activated automatically after a predetermined number of navigations by said user,

wherein said automatically recognizing, without human intervention, comprises:

considering a history of the browser based on said query entered in said browsing by said user;

determining, based on said history and said query, whether an automated help resource is necessary;

determining, based on said history and said query, whether a human help resource is necessary; and

routing said user to at least one of said automated help resource and said human help resource, to help said user (emphasis added).

On the other hand, independent claim 28 recites, *inter alia*, a method for conducting electronic commerce, including:

browsing for an item at an electronic store (e-Store) over an electronic medium;

automatically recognizing, without human intervention, that the user is lost in attempting to find said item; and

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interactively querying, at any time during a session, of said user whether the user needs help in finding said item,
wherein said automatically recognizing comprises:
considering a history of the browser based on a query entered in said browsing by a user;
determining, based on said history and said query, whether an automated help resource is necessary;
determining, based on said history and said query, whether a human help resource is necessary; and
routing said user to at least one of said automated help resource and said human help resource, to help said user (emphasis added).

Somewhat similarly, independent claim 31 recites, *inter alia*, a method for conducting electronic commerce, including:

browsing, by a user, for an item at an electronic store (e-Store) over an electronic medium;
automatically considering, without human intervention, a history of said browser based on a query entered in said browsing by said user;
automatically determining, without human intervention, based on said history and said query, whether an automated help resource should be launched;
automatically determining, without human intervention, based on said history and said query, whether a human help resource should be contacted;
automatically routing, without human intervention, said user to at least one of said automated help resource and said human help resource, to help said user (emphasis added).

As mentioned above, the present invention provides extensive software sophistication to track user behavior, e.g., navigating, browsing, clicking, searching, etc., to determine what the user might be looking for. The present invention includes extensive facilities for the customer to practice his/her typical behavior using the Internet browser, i.e., navigating, browsing, clicking, or searching, and tracks these behaviors to provide help in a behavioral context by directing the customer to the appropriate category with dynamic help or a live person who can help either through a chat system or a phone line. That is, the present invention can automatically

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determine, without human intervention, whether it is appropriate to direct the user to a help category or to a person who is an expert in the area of the customer's query, and then can direct the user to the appropriate help category.

The Marriott article and the Icontact.com press release disclose a method in which a human monitors the activity of users on web pages and then contacts the user to assist the customer visiting the web site with their shopping.

More particularly, the Marriott article and the Icontact.com press release disclose that the user is recognized as a regular shopper, remembers what this customer has previously purchased and knows how long the shopper usually spends on the web site (see the Marriott article at the fourth paragraph). The human representatives (i.e., "NetReps") have access to archived databases of previous customer navigation and buying patterns (e.g., see the Marriott article at the sixth paragraph).

In contrast to the method described in the Marriott article and the Icontact.com press release, the claimed method provides a novel and unobvious combination of elements in which the method automatically recognizes, without human intervention, that the user is lost in attempting to find an item, as opposed to having a human reviewing the user's web site activity. By automatically recognizing, without human intervention, that the user is lost, the claimed method can then determine whether human intervention is necessary or whether non-human intervention should be launched.

In other words, the claimed method determines whether the user is lost, and then routes the user to the right (i.e., relevant) kind of software or calls an external help facility to help the user (e.g., see specification at page 7, lines 14-16).

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Thus, Applicant respectfully submits that the claimed invention does not merely automate a manual activity which accomplishes the same result, as alleged by the Examiner. Instead, the claimed invention recites a unique combination of elements that define a novel and unobvious method for conducting electronic commerce that accomplishes a clearly different result which is not disclosed or suggested by the method described in the cited Marriott article and Icontact.com press release.

Again, the claimed method determines whether the user is lost and then routes the user to the right (i.e., relevant) kind of software or calls an external help facility to help the user (e.g., see specification at page 7, lines 14-16).

In comparison, the method described in the Marriott article and the Icontact.com press release clearly does not disclose or suggest automatically recognizing, without human intervention, whether the user is lost, as claimed. Moreover, the Marriott article and the Icontact.com press release clearly does not disclose or suggest automatically determining whether human intervention is necessary or whether non-human intervention should be launched, as claimed, for example, in independent claim 31.

On the contrary, the method described by the Marriott article and the Icontact.com press release discloses that one of the hurdles with the method is convincing the shoppers (i.e., users) “that the help they are getting is being provided by a real person and not some kind of artificial intelligence” (e.g., see the Marriott article at the next to last paragraph (i.e., twenty-eighth paragraph)).

In other words, the method described by the Marriott article and the Icontact.com press release teach away from the claimed invention, since only human intervention is disclosed or suggested as being fruitful or valuable to users.

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Moreover, the method described by the Marriott article and the Icontact.com press release clearly does not disclose or suggest “said electronic store assistant is implemented in software as one of a program and a search window which is activated based on one of a query and activated automatically after a predetermined number of navigations by said user.”

On the contrary, the method described by the Marriott article and the Icontact.com press release teaches only that a real person assists the user.

Applicant further notes that, with respect to claims 26-34, the Examiner merely states that “[c]laims 26-34 are rejected under the same rationale as set forth above in claims 1-5 and 7-9” (see Office Action at page 5, lines 11-12). However, the Examiner’s statement clearly does not establish a *prima facie* case with respect to the additional features recited in these claims (which were added by the Amendment under 37 C.F.R. § 1.111 filed on May 17, 2004), or for that matter, even demonstrate that the features of claims 26-34 properly were considered by the Examiner. Thus, Applicant submits that these claims are patentable over Icontact.com as a matter of law.

Moreover, with respect to dependent claims 2-5, 7-9, 30, and 32-34, Applicant submits that these claims are patentable over Icontact.com by virtue of their dependency from independent claims 1, 38, and 31, respectively, as well as for the additional features recited therein.

For example, claims 30 and 32 recite, *inter alia*, that the “automated help resource comprises a help source that automatically assists said user without human intervention” (emphasis added).

Claim 33 recites, *inter alia*, that the “automated help resource interactively queries, at any time during a session, said user whether the user needs assistance with said browsing” (emphasis

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added). On the other hand, claim 34 recites, *inter alia*, that the "human help resource interactively queries, at any time during a session, said user whether the user needs assistance with said browsing" (emphasis added).

Icontact.com clearly does not disclose or suggest these features of the claimed invention.

For at least the reasons outline above, Applicant respectfully submits that the method described by the Marriott article and the Icontact.com press release does not disclose, teach or suggest all of the features of independent claim 1.

Therefore, Applicant respectfully submits that the rejection of claims 1-5, 7-9, 26-28, and 30-34 should be withdrawn and that these claims should be permitted to pass to allowance.

III. CONCLUSION

In view of the foregoing, Applicant submits that claims 1-5, 7-9, 26-28, and 30-34, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

As mentioned above, this Amendment is filed within two-months of the Office Action since the two-month due date of October 23, 2004 fell on a weekend. Thus, should any extension of time fees become necessary due to the issuance of an Advisory Action, the extension of time fees should be calculated from the date of the Office Action or the mailing date of the Advisory Action, whichever is later.


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The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 09-0441.

Respectfully Submitted,

Date: October 25, 2004



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CERTIFICATE OF TRANSMISSION

I certify that I transmitted via facsimile to (703) 872-9306 the enclosed Amendment under 37 C.F.R. § 1.116 to Examiner Matthew S. Gart on October 25, 2004.


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